

REMARKS

Assignee respectfully requests entry of the following amendments and remarks in response to the Final Office Action mailed January 21, 2010. Assignee submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 21 and 23 are pending. In particular, Assignee amends claims 1, 5, and 14. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Claim Objections

The Office Action objects to claim 1 for various informalities. Assignee amends claim 1, as indicated above and suggested in the Office Action. Assignee submits that these amendments overcome this objection.

II. Rejections Under 35 U.S.C. §103

A. Claim 1 is Allowable Over *Lee* and *Penner*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). This rejection is improper for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a first sender to a first recipient;
waiting a predefined time interval for an input from the first recipient, the input being responsive to the IM message;
determining whether input from the first recipient is received during the predetermined time interval;
in response to determining that no input from the first recipient is received during the predetermined time interval, prompting the first sender to forward the IM message from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the first sender,
wherein in response to a determination that the recipient is engaged in an IM session with a second sender, the first sender is queried to join the IM session, wherein in response to determining that the first sender desires to join the IM session, the second sender is queried to determine whether to allow the first sender to join the IM session, and ***wherein querying the second sender to allow the first sender to join the IM session includes an automatically generated response to the IM message from the first sender to the first recipient by an IM client of the first recipient, without input from the first recipient.***

(Emphasis added).

Claim 1 is allowable over the cited art for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses, teaches, or suggests a “communication method... wherein in response to determining that the first sender desires to join the IM session, the second sender is queried to determine whether to allow the first sender to join the IM session, and ***wherein querying the second sender to allow the first sender to join the IM session includes an automatically generated response to the IM message from the first sender to the first recipient by an IM client of the first recipient, without input from the first recipient***” as recited in claim 1. More specifically, *Lee* discloses “[i]f a predetermined time limit is surpassed, the monitor 1005 will take program dependent action such as inform the meeting requester that the meeting cannot be scheduled because of the meeting constraints, or the meeting is scheduled with the meeting constraints not being met” (page 3, paragraph [0053]). However, *Lee* fails to suggest anything related to an automatically generated response to the IM message, as recited in claim 1.

Further, *Penner* fails to overcome the deficiencies of *Lee*. More specifically, *Penner* discloses "[i]n one embodiment, the transfer is accomplished when the first recipient user receives a message composed by a sender and initiates a message... to the second recipient" (column 5, line 1). However, this is completely different than "communication method... wherein in response to determining that the first sender desires to join the IM session, the second sender is queried to determine whether to allow the first sender to join the IM session, and ***wherein querying the second sender to allow the first sender to join the IM session includes an automatically generated response to the IM message from the first sender to the first recipient by an IM client of the first recipient, without input from the first recipient***" as recited in claim 1. For at least these reasons, claim 1 is allowable.

B. Claim 5 is Allowable Over *Lee* and *Penner*

The Office Action indicates that claim 5 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). This rejection is improper for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 5. More specifically, claim 5 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a first sender to a recipient;
determining whether input from the first recipient is received during a predetermined time interval;
in response to determining that no input is received from the first recipient during the predetermined time interval, determining whether the first recipient is engaged in an IM chat session with a second sender; and
in response to determining that the first recipient is engaged in an IM chat session with the second sender, prompting the first sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Claim 5 is allowable for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses, teaches, or suggests a “communication method comprising... ***in response to determining that the first recipient is engaged in an IM chat session with the second sender, prompting the first sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender***” as recited in claim 5. More specifically, as indicated by the Office Action, *Lee* discloses “[i]f a predetermined time limit is surpassed, the monitor 1005 will take program dependent action such as inform the meeting requester that the meeting cannot be scheduled because of the meeting constrains, or the meeting is scheduled with the meeting constraints not being met” (page 3, paragraph [0053]). As illustrated in this passage, *Lee* discloses that, in response to a predetermined time limit being surpassed, the meeting either will not be scheduled or will be scheduled without certain constraints. This has absolutely nothing to do with prompting the first sender to forward an instant message, as recited in claim 5.

Further, *Penner* fails to overcome the deficiencies of *Lee*. More specifically, as cited by the Office Action, *Penner* discloses “the IM server appliance 210 permits the transfer of an IM message from a first recipient user to a second recipient (e.g., a third party such as a transfer from an administrative to an executive)” (column 4, line 62). The Office Action argues that this is “essentially a similar concept of forwarding the message from [a] first recipient to [a] second recipient as *Penner* further disclose [i]n one embodiment, the chat may be automatically transferred in response to a user-defined setting” (OA page 4, line 11). Assignee disagrees. First, there is nothing in *Penner* that even suggests that transferring an IM message from a first recipient to a second recipient is performed in response to anything. Second, the Office Action assertion that “a user-defined” setting is essentially the same as “***prompting the first sender to forward the instant message...***” is simply incorrect for at least the reason that the user-defined

setting in *Penner* is a setting provided to the first recipient. There is nothing in *Penner* even suggesting that this option is provided to the first sender. Further, a user-defined setting is different than "***prompting the first sender to forward the instant message...***" for at least the additional reason that a user defined setting is not set/reset "***in response to determining that the first recipient is engaged in an IM chat session with the second sender***" as is the case in claim 5. For at least these reasons, this rejection is improper and claim 5 is allowable.

C. Claim 10 is Allowable Over *Lee* and *Penner*

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). This rejection is improper for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 10. More specifically, claim 10 recites:

A computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following:

receive an instant messaging (IM) message from a sender to a first recipient;

wait a predefined time interval for an input from the first recipient, the input being responsive to the IM message;

determine whether input from the first recipient is received during the predetermined time interval; and

in response to determining that no input from the first recipient is received during the predetermined time interval, prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Claim 10 is allowable for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses, teaches, or suggests a "computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following... ***in response to determining that no input from the first recipient is received during the***

predetermined time interval, prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender” as recited in claim 10. More specifically, as indicated by the Office Action, *Lee* discloses “[i]f a predetermined time limit is surpassed, the monitor 1005 will take program dependent action such as inform the meeting requester that the meeting cannot be scheduled because of the meeting constraints, or the meeting is scheduled with the meeting constraints not being met” (page 3, paragraph [0053]). As illustrated in this passage, *Lee* discloses that, in response to a predetermined time limit being surpassed, the meeting either will not be scheduled or will be scheduled without certain constraints. This has absolutely nothing do with prompting the first sender to forward an instant message, as recited in claim 10.

Further, *Penner* fails to overcome the deficiencies of *Lee*. More specifically, as cited by the Office Action, *Penner* discloses “the IM server appliance 210 permits the transfer of an IM message from a first recipient user to a second recipient (*e.g.*, a third party such as a transfer from an administrative to an executive)” (column 4, line 62). The Office Action argues that this is “essentially a similar concept of forwarding the message from [a] first recipient to [a] second recipient as *Penner* further disclose [i]n one embodiment, the chat may be automatically transferred in response to a user-defined setting” (OA page 4, line 11). Assignee disagrees. First, there is nothing in *Penner* that even suggests that transferring an IM message from a first recipient to a second recipient is performed in response to anything. Second, the Office Action assertion that “a user-defined” setting is essentially the same as “***prompt[ing] the first sender to forward the instant message...***” is simply incorrect for at least the reason that the user-defined setting in *Penner* is a setting provided to the first recipient. There is nothing even suggesting that this option is provided to the first sender. Further, a user-defined setting is different than “***prompt[ing] the first sender to forward the instant message...***” for at least the additional reason that a user defined setting is not set/reset “***in response to determining***

that the first recipient is engaged in an IM chat session with the second sender” as is the case in claim 10. For at least these reasons, this rejection is improper and claim 10 is allowable.

D. Claim 14 is Allowable Over Lee and Penner

The Office Action indicates that claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 (“*Lee*”) in view of U.S. Publication Number 7,328,247 (“*Penner*”). This rejection is improper for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 14. More specifically, claim 14 recites:

A computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following:

receive an instant messaging (IM) message from a first sender to a first recipient;

determine whether input from the first recipient is received during a predetermined time interval;

in response to determining that no input from the first recipient is received during the predetermined time interval, determine whether the first recipient is engaged in an IM chat session with second sender; and

in response to determining that the first recipient is engaged in an IM chat session with the second sender prompt the first sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Claim 14 is allowable for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses, teaches, or suggests a “computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following... ***in response to determining that the first recipient is engaged in an IM chat session with the second sender prompt the first sender to forward the instant message from the first***

recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender" as recited in claim 14. More specifically, as indicated by the Office Action, *Lee* discloses "[i]f a predetermined time limit is surpassed, the monitor 1005 will take program dependent action such as inform the meeting requester that the meeting cannot be scheduled because of the meeting constraints, or the meeting is scheduled with the meeting constraints not being met" (page 3, paragraph [0053]). As illustrated in this passage, *Lee* discloses that, in response to a predetermined time limit being surpassed, the meeting either will not be scheduled or will be scheduled without certain constraints. This has absolutely nothing to do with prompting the first sender to forward an instant message, as recited in claim 14.

Further, *Penner* fails to overcome the deficiencies of *Lee*. More specifically, as cited by the Office Action, *Penner* discloses "the IM server appliance 210 permits the transfer of an IM message from a first recipient user to a second recipient (*e.g.*, a third party such as a transfer from an administrative to an executive)" (column 4, line 62). The Office Action argues that this is "essentially a similar concept of forwarding the message from [a] first recipient to [a] second recipient as *Penner* further disclose [i]n one embodiment, the chat may be automatically transferred in response to a user-defined setting" (OA page 4, line 11). Assignee disagrees. First, there is nothing in *Penner* that even suggests that transferring an IM message from a first recipient to a second recipient is performed in response to anything. Second, the Office Action assertion that "a user-defined" setting is essentially the same as "***prompt[ing] the first sender to forward the instant message...***" is simply incorrect for at least the reason that the user-defined setting in *Penner* is a setting provided to the first recipient. There is nothing even suggesting that this option is provided to the first sender. Further, a user-defined setting is different than "***prompt[ing] the first sender to forward the instant message...***" for at least the additional reason that a user defined setting is not set/reset "***in response to determining that the first recipient is engaged in an IM chat session with the second sender***" as is the

case in claim 14. For at least these reasons, this rejection is improper and claim 14 is allowable.

E. Claim 19 is Allowable Over Lee and Penner

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("Lee") in view of U.S. Publication Number 7,328,247 ("Penner"). This rejection is improper for at least the reason that Lee in view of Penner fails to disclose, teach, or suggest all of the elements of claim 19. More specifically, claim 19 recites:

A communication system comprising:
means for receiving an instant messaging (IM) message
from a sender to a first recipient;
means for determining whether the first recipient has
provided an input during a predefined time interval;
means for, in response to determining that the first
recipient has not provided an input during the predetermined time
interval, determining whether the first recipient is engaged in an
IM chat session with another sender;
means for, in response to determining that the first
recipient is engaged in an IM chat session with another sender,
replying to the IM message; and
***means for, in response to determining that the first
recipient is not engaged in an IM chat session with another
user, prompting the sender to forward the instant message
from the first recipient to a second recipient and indicate, by
the first recipient, that the IM message originated from the
sender,***
wherein all the means are embodied as hardware
controlled by software.

(Emphasis added).

Claim 19 is allowable for at least the reason that neither Lee nor Penner, taken alone or in combination, discloses, teaches, or suggests a "communication system comprising... ***means for, in response to determining that the first recipient is not engaged in an IM chat session with another user, prompting the sender to forward the instant message from the first recipient to a second recipient and indicate, by the first recipient, that the IM***

message originated from the sender" as recited in claim 19. More specifically, as indicated by the Office Action, *Lee* discloses "[i]f a predetermined time limit is surpassed, the monitor 1005 will take program dependent action such as inform the meeting requester that the meeting cannot be scheduled because of the meeting constraints, or the meeting is scheduled with the meeting constraints not being met" (page 3, paragraph [0053]). As illustrated in this passage, *Lee* discloses that, in response to a predetermined time limit being surpassed, the meeting either will not be scheduled or will be scheduled without certain constraints. This has absolutely nothing to do with prompting the first sender to forward an instant message, as recited in claim 19.

Further, *Penner* fails to overcome the deficiencies of *Lee*. More specifically, as cited by the Office Action, *Penner* discloses "the IM server appliance 210 permits the transfer of an IM message from a first recipient user to a second recipient (e.g., a third party such as a transfer from an administrative to an executive)" (column 4, line 62). The Office Action argues that this is "essentially a similar concept of forwarding the message from [a] first recipient to [a] second recipient as *Penner* further disclose [i]n one embodiment, the chat may be automatically transferred in response to a user-defined setting" (OA page 4, line 11). Assignee disagrees. First, there is nothing in *Penner* that even suggests that transferring an IM message from a first recipient to a second recipient is performed in response to anything. Second, the Office Action assertion that "a user-defined" setting is essentially the same as **"prompting the first sender to forward the instant message..."** is simply incorrect for at least the reason that the user-defined setting in *Penner* is a setting provided to the first recipient. There is nothing even suggesting that this option is provided to the first sender. Further, a user-defined setting is different than **"prompting the first sender to forward the instant message..."** for at least the additional reason that a user defined setting is not set/reset **"in response to determining that the first recipient is engaged in an IM chat session with the second sender"** as is the case in claim 19. For at least these reasons, this rejection is improper and claim 19 is allowable.

F. **Claim 20 is Allowable Over Lee and Penner**

The Office Action indicates that claim 20 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). This rejection is improper for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 20. More specifically, claim 20 recites:

A communication system comprising:
a memory component that stores:

instant-messaging (IM) receive logic configured to receive an IM message from a sender to a first recipient;

first determining logic configured to determine whether the first recipient has provided an input during a predefined time interval;

second determining logic configured to, in response to determining that the first recipient has not provided an input during the predetermined time interval, determine whether the first recipient is engaged in an IM chat session with another sender;

reply logic configured to, in response to determining that the first recipient is engaged in an IM chat session with another sender, reply to the IM message; and

prompting logic configured to, in response to determining that the first recipient is not engaged in an IM chat session with another sender, prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Claim 20 is allowable for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses, teaches, or suggests a "communications system comprising...

prompting logic configured to, in response to determining that the first recipient is not engaged in an IM chat session with another sender, prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender" as recited in claim 20. More specifically, as indicated by the Office Action, *Lee* discloses "[i]f a predetermined time limit is

surpassed, the monitor 1005 will take program dependent action such as inform the meeting requester that the meeting cannot be scheduled because of the meeting constraints, or the meeting is scheduled with the meeting constraints not being met" (page 3, paragraph [0053]). As illustrated in this passage, *Lee* discloses that, in response to a predetermined time limit being surpassed, the meeting either will not be scheduled or will be scheduled without certain constraints. This has absolutely nothing to do with prompting the first sender to forward an instant message, as recited in claim 20.

Further, *Penner* fails to overcome the deficiencies of *Lee*. More specifically, as cited by the Office Action, *Penner* discloses "the IM server appliance 210 permits the transfer of an IM message from a first recipient user to a second recipient (*e.g.*, a third party such as a transfer from an administrative to an executive)" (column 4, line 62). The Office Action argues that this is "essentially a similar concept of forwarding the message from [a] first recipient to [a] second recipient as *Penner* further disclose [i]n one embodiment, the chat may be automatically transferred in response to a user-defined setting" (OA page 4, line 11). Assignee disagrees. First, there is nothing in *Penner* that even suggests that transferring an IM message from a first recipient to a second recipient is performed in response to anything. Second, the Office Action assertion that "a user-defined" setting is essentially the same as "***prompt[ing] the first sender to forward the instant message...***" is simply incorrect for at least the reason that the user-defined setting in *Penner* is a setting provided to the first recipient. There is nothing even suggesting that this option is provided to the first sender. Further, a user-defined setting is different than "***prompt[ing] the first sender to forward the instant message...***" for at least the additional reason that a user defined setting is not set/reset "***in response to determining that the first recipient is engaged in an IM chat session with the second sender***" as is the case in claim 20. For at least these reasons, this rejection is improper and claim 20 is allowable.

G. Claims 2, 3, 9, 11, 12, and 18 are Allowable Over *Lee* and *Penner*

The Office Action indicates that claims 2, 3, 9, 11, 12, and 18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). This rejection is improper for at least the reason that *Lee* and *Penner* fail to disclose, teach, or suggest all of the elements of claims 2, 3, 9, 11, 12, and 18. More specifically, dependent claims 2 and 3 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claim 9 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 5. Dependent claims 11 and 12 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 10. Further, dependent claim 18 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 14. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

H. Claims 4, 8, 13, and 17 are Allowable Over *Lee*, *Penner*, and *Murphy*

The Office Action indicates that claims 4, 8, 13, and 17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") and U.S. Publication Number 7,328,247 ("*Penner*") in view of U.S. Publication Number 2007/0274497 ("*Murphy*"). This rejection is improper for at least the reason that *Lee* and *Penner* in view of *Murphy* fails to disclose, teach, or suggest all of the elements of claims 4, 8, 13, and 17. More specifically, dependent claim 4 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 1. Dependent claim 8 is allowable for at least the reason that this claim depends from and includes the

elements of allowable independent claim 5. Dependent claim 13 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 10. Further, dependent claim 17 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 14. Because *Murphy* fails to overcome the deficiencies of *Lee* and *Penner*, claims 4, 8, 13, and 17 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

I. Claims 6, 7, 15, and 16 are Allowable Over Lee, Penner, and Manabe

The Office Action indicates that claims 6, 7, 15, and 16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") and U.S. Publication Number 7,328,247 ("*Penner*") in view of U.S. Patent Number 6,584,494 ("*Manabe*"). This rejection is improper for at least the reason that *Lee* and *Penner* in view of *Manabe* fails to disclose, teach, or suggest all of the elements of claims 6, 7, 15, and 16. More specifically, dependent claims 6 and 7 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 5. Further, dependent claims 15 and 16 are allowable for at least the reason that they depend from and include the elements of allowable independent claim 14. Because *Manabe* fails to overcome the deficiencies of *Lee* and *Penner*, claims 6, 7, 15, and 16 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

J. Claims 21 and 23 are Allowable Over Lee, Penner, Matsumoto, and NWG

The Office Action indicates that claims 21 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") and U.S. Publication Number 7,328,247 ("*Penner*") in view of U.S. Patent Number 4,639,889

("Matsumoto") and further in view of "XMPP Instant Messaging" by Network Working Group ("NWG"). This rejection is improper for at least the reason that *Lee* and *Penner* in view of *Matsumoto* and *NWG* fails to disclose, teach, or suggest all of the elements of claims 21 and 23. More specifically, dependent claims 21 and 23 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 20. Because *Matsumoto* and *NWG* fail to overcome the deficiencies of *Lee* and *Penner*, claims 21 and 23 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

III. **Allegedly Well Known Subject Matter**

In addition, in rejecting claims 1 and 10, the Office Action argues "Penner further discloses that this transferring mechanism can be automated in response to user-defined settings which means sender may have a setting which may require the first recipient to forward the message to second recipient or first recipient may ask for permission from sender before transferring the message to second recipient etc. user attributes and user-defined setting are well known in the art to control the specific application function on behalf of recipient, sender or user)" (OA page 6, third to last line). Further, in rejecting claims 5 and 14, the Office Action states "it is well known in the art to that status can be customize[d] as per user preferences" (OA page 7, last line).

Assignee respectfully traverses the alleged finding of well known subject matter and submits that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required. Additionally, Assignee submits that merely providing a reference (or a couple of references) that allegedly discloses the subject matter in question, does not rise to an evidentiary level of being

well known in the industry. Assignee submits that even if the cited references disclose the subject matter in question (a point that the Assignee is not conceding), presence of that subject matter in a reference does not raise the level of commonality of that subject matter to something of unquestionable fact. For at least this specific and particular reason, the subject matter in question is not well known in the art.

Assignee additionally submits that particularly in the context of the claimed combination that includes "an automatically generated response to the IM message from the sender to the first recipient by an IM client of the first recipient, without input from the first recipient" and "prompting the first sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender," the subject matter in question is too complex for a reasonably skilled person to consider it to be well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Assignee respectfully submits that the subject matter in question is not well known in the art, respectfully traverses the alleged finding of well known subject matter, and submits that claim 1, 5, and 14 are patentable in view of the cited art.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

Anthony F. Bonner Jr. Reg. No. 55,012

AT&T Legal Department – TKHR
Attn: Patent Docketing
One AT&T Way
Room 2A-207
Bedminster, NJ 07921
Customer No.: 38823